

P37034

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE OFFICE OF PETITIONS**

In re Patent Application of:
Cindy KOHANEK et al.

Application No.: 09/904,425

Confirmation No.: 1776

Filed: July 12, 2001

Art Unit: 2859

For: LINEARITY MEASURING APPARATUS FOR
WAFER ORIENTATION FLAT

Examiner: G. Bradley Bennett

Attorney Docket No.: P37034

SUPPLEMENTAL DECLARATION OF RUTH MONTALVO

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

I, RUTH MONTALVO, hereby declare and state as follows:

1. I have previously executed a Declaration of Ruth Montalvo (hereinafter "Montalvo Declaration"), dated January 27, 2009, in connection with the above-identified application, and incorporate by reference the contents of that Montalvo Declaration in full herein;

2. I confirm that I am still presently employed by the Firm of Reed Smith LLP ("Reed Smith") (www.reedsmith.com). I have been employed by Reed Smith since July 3, 2000 as an IP Specialist, where my main responsibilities include overseeing patent docketing, processing incoming mail received from the U.S. Patent and Trademark Office (hereinafter

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"U.S. PTO" and outgoing mail for delivery to the U.S. PTO, and assisting lawyers with the preparation and filing of all types of documents with the U.S. PTO;

3. Pursuant to a request received from the Greenblum & Bernstein law firm of Reston, Virginia, I performed a further search of some business records of Reed Smith to find certain information that might concern two particular patent applications which, at one time, were believed to be entrusted to Reed Smith, through a former Reed Smith partner, Jules Goldberg, Esq. As stated in the Montalvo Declaration, I had previously performed a search of these business records in connection with the Montalvo Declaration. In particular, these applications were believed to be known as Application Serial No. 09/904,425 (hereinafter "the '425 application"), filed on July 12, 2001 for inventors Cindy Kohanek and Gary Babb, entitled "Linearity Measuring Apparatus for Wafer Orientation Flat," and Application Serial No. 09/718,659 (hereinafter "the '659 application"), filed on November 22, 2000 for inventors Kazuhiro Harada, Hisashi Furuya, Jur Furukawa, Ken Nakamira, Niroyuki Shiraki, and Yukio Muroi, entitled "Silicon Water and Method for Manufacturing the Same;"

4. As previously noted in the Montalvo Declaration, among the database systems and business records used by Reed Smith to organize and manage its legal work on behalf of its many clients, especially on the patent side of the firm's practice, is a system known as "PATTSY." "PATTSY" is a commercially available database system that has been used by Reed Smith for about seven years, especially for firm work before the U.S. PTO which involves many due dates and other data involved in this specialized aspect of the firm's many practices. A general discussion of a generic "PATTSY" system apparently offered by O P Solutions can be found at <http://www.opsolutions.com/>;

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5. I personally looked for data concerning the '425 and '659 applications in Reed Smith's "PATTSY" database docketing system. I found such data in 'PATTSY," which is discussed in detail in the Montalvo Declaration;

6. In addition to the Reed Smith "PATTSY" database system, as I noted in the Montalvo Declaration, "paper files" for the '425 and '659 applications were opened and maintained at Reed Smith during the time period those applications were in the possession, custody, and control of Reed Smith (which is no longer the case), as was and is still done as part of the basic practice at Reed Smith for all such patent "paper files." The physical makeup of the Reed Smith patent "paper files" is and remains of the type that is relatively standard in most law firms which handle patent prosecution matters, among other things, in that the physical file is basically a three-fold file, i.e., a left-hand section, a middle section, and a right-hand section, which generally contains papers relating to the underlying patent application, including papers to/from the U.S. PTO and to/from the client;

7. On or about January 8, 2009, I personally ran database inquiries in the Reed Smith "PATTSY" database system relative to the '425 and '659 applications, and then printed copies of the results from those inquiries with true and correct PDF copies of the foregoing printouts being cut-and-pasted into the Montalvo Declaration, and further, separate and clearer copies of these printouts being attached to the Montalvo Declaration as Ex. 4 and 5, respectively;

8. Another true and correct PDF copy of the printout for the '659 application is cut and pasted on the next page, and another copy of Ex. 4 is attached hereto;

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REED SMITH "PATTSY" RUN FOR '425 APPLICATION

YOUR#	SU-5072			PRINTED ON:	01/02/2004
COUNTRY	US UNITED STATES			TITLE	LINEARITY MEASURING APPARATUS FOR WAFER ORIENTATION FLAT
NEWCOM	OTH	SERIAL#	0000445	PROR	06/18/2001
RELATED	RNA	PATENT#		REL	07/12/2001
TYPE	UTL	STATUS	TRANSFER	PUBL	12/19/2002
CLIENT	SU	SUDA PAT.OFF. 1500577	1	CRIF	FILE221US
AGENT				AREF	
				YTD	Y 01/02/2004

ID	O	ACTION	DATE	DUE IN	CASE	EXTNS	FINAL	EXT	RESPONSE	CALL UP	1	2	3
	N	AWAITING NEWCOM	00/12/2001	2 M	00/12/2001		00/12/2001	D	00/12/2001		Y	Y	Y
	N	DECLARATION DUE	00/29/2001	2 M	00/29/2001	4	00/29/2001	A	00/12/2001		Y	Y	Y
	N	FILING RECEIPT	00/12/2002	2 M	00/12/2002		00/12/2002	D	00/29/2002		Y	Y	Y
	N	3MON DUE DATE	01/03/2002	3 M	00/12/2002	3	01/03/2002	S	01/01/2002		Y	Y	Y
AN	N	AMEND PUBLICATION	12/19/2002	2 M	02/19/2003		02/19/2003	D	11/02/2003		Y	Y	Y
	N	AS NOTICE/PETITION	00/29/2003	2 M	05/29/2003		05/29/2003	D	01/02/2003		Y	Y	Y
NOTICE OF ABANDONMENT RECD DATED 23MARCH2003 BUT THE PTO HAS NOT RECD THE PETITION FILED 6FEB2003													
SC	N	STATUS CHECK	00/29/2003	8 M	00/29/2003		00/29/2003	D	01/02/2003		Y	Y	Y
SC	N	CASE TRANSFERRED	01/02/2003	6 M	01/02/2003		01/02/2003	D	01/02/2003		Y	Y	Y

Transferred to J.E. Goldberg & Duane Morris LLP, 1540 Broadway, New York, NY 10036-6005. JS Direct: 212-692-1000 (Ext 212-692-1000) Fax: 212-692-1023

INVENTORS	ASSIGNEES	TERMS
CINDY KHAMER	INTERJEN MAT. SILICON CORP.	502577 20035
GARY BADE	Interjen Silicon America Corporation	

PRIOR APPLICATIONS						
REFERENCE#	ENTRY	SERIAL#	FILED	TITLE/DESCRIPTION	TYPE	
	JP	2001-483702	00/18/2001		APPL	
USED DEFINABLE FIELDS				PATENT FIELDS		
STAT	Pending	SMALL ENTITY	No	PUBL #		
PRV	2001-183702	NO CLAIMS		ART UNIT	2858	
PBL	US-2002-0182118-A1	TOTAL CLAIMS		CONFIRM	1775	
				EXAMINER		

PD4139US00 ENTERED 01/01/2004 MODIFIED 01/03/2004 BY PMT

ATTORNEYS: JG / N/A / N/A

NOTES
PD Subm AMP 12FEB03

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9. I provide in the following paragraphs of this Supplemental Declaration a general description of some of the data and data entries shown on the foregoing printed copy of the database inquires I ran in the Reed Smith "PATTSY" database system relative to the '425 application;

Regarding Ex. 4 concerning the '425 application:

a. The printout shown as Ex. 4 indicates that a U.S. PTO Office Action was issued on July 3, 2002. The printout also indicates that a Response was due October 3, 2002, extendable to January 3, 2003. The printout is unclear as to whether a Response was filed, as the response date entered is January 1, 1900;

b. The printout indicates that a Notice of Abandonment was issued March 26, 2003 and docketed for a 2 month response. The printout also includes a note associated with this entry which refers to a Petition filed February 6, 2003, but no reference to the Petition is elsewhere in this printout;

c. The printout indicates that attorney "JG" was assigned to this case (see "Attorneys" field towards the bottom of the printout). The second and third slots in the Attorney field show "N/A," which means "not applicable;" and

d. The printout includes entries for AB (U.S. PTO Board of Appeals and Interferences) Notice/Petition (due May 26, 2003) and Status Check (due September 26, 2003), which were left open and overdue. Both were closed on January 2, 2008;

10. I have reviewed the contents of a copy of the '425 application that has been forwarded to me by the Greenblum & Bernstein law firm. A review of the copy of the file of the '425 application reveals:

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(a) an Office Action was mailed July 3, 2002 from the U.S. PTO.

The Office Action appears with a docketing stamp thereon with handwriting indicating:

Docket Due Oct. 3, 2002 Reply Due
Jan. 3, 3003 Reply Deadline

(A copy of the front and back page of the PTO-90C of the Office Action is attached as Exhibit A); and

(b) a Notice of Publication mailed December 19, 2002 appearing with a docketing stamp thereon without handwriting;

11. A review of the face of the file of the '425 application (a copy attached as Exhibit B) reveals a "Petition to Revive" with mailed and filed dates indicated as "2-6-2003, "Awaiting Answer to Petition" with a date of "6-6-2003" and "Abandonment Recd" with a date of 3-26-2003. However, a review of the file does not reveal a Petition to Revive or a Notice of Abandonment being present in the file;

12. The printed copy of the database inquires attached as Ex. 4 for the '425 application indicates receipt of a Notice of Abandonment, and includes "NOTICE OF ABANDONMENT REC'D DATED 26MARCH2002 BUT THE PTO HAS NOT REC'D THE PETITION FILED 6FEB2003.";

13. I have searched the computer records at Reed Smith and have located a paper entitled, "Petition To Revive Pursuant to 37 CFR 1.137(b)". A copy of the search and the paper are attached as Exhibit C. The paper includes a date on the bottom of February 6, 2003. The date indicated with the Express Mail stamp of September 16, 2009 is the present date of printing of the document;

14. It is further noted that our docketing system provides lists that can be reviewed by attorneys and/or their assistants providing future dates as well as past due dates. A search has been made to try and locate lists to ascertain if any of these lists included information regarding future or past due dates in connection with the '425 application. However, lists could not be found relating to the '425 application for any period between the mailing of the Office Action and December 2008, and therefore there is no indication as to whether these lists indicated any entries concerning the '425 application;

15. As set forth in the Montalvo Declaration and as set forth in the present Supplemental Declaration, Reed Smith uses a commercial database system known as "PATTSY" to manage the prosecution of applications including keeping track of due dates and the filing of papers before the U.S. PTO. The docketing department at Reed Smith, at the time of the abandonment of the '425 application, included three experienced persons whose duties included receiving and entry of papers from the U.S. PTO into the files, entry of papers into the docketing system, and communicating with attorneys regarding due dates. This commercial docketing system has successfully been used by the experienced persons of Reed Smith, with the exception of a couple of situations, including the present situation, both of which were discovered at the same time. Papers with the client and with respect to the U.S. PTO are ordinarily properly placed of record in files, and follow up actions are thereafter taken based upon entry into docketing system. In the instant situation, despite the exercise of due care and diligence in using our docketing system, which

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ordinarily accurately keeps track of the status of patent applications and due dates associated therewith, on information and belief, errors were made upon entering the Notice of Abandonment and the Petition for Revival in the docketing system which led to the delay in becoming aware of the abandonment. To my recollection and having first hand knowledge of activities of the docketing department during the period between the mailing of the Office Action and December 2008, I was not aware of the errors in the docketing system with respect to the '425 application until becoming aware in connection with the preparation of the Montalvo Declaration and this Supplemental Declaration, and on information and belief, I do not believe that anyone associated with the docketing department was aware of the errors in the docketing system with respect to the '425 application until about December 2008. In fact, had I, and on information and belief, anyone in the docketing department, been aware of the errors in the docketing system with respect to the '425 application, based upon normal course of operation of the docketing department, would have taken all steps to ensure the appropriate docketing and revival of the application;

16. In signing this Supplemental Declaration, I understand that this Supplemental Declaration will be filed as evidence in support of a Petition to Revive the '425 application; and

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I declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true. I further declare that these statements were made with the knowledge and understanding that willful false statements and the like so made are punishable by fine, or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of any U.S. patent issued from such application.

Dated: 30 Oct 2009

Respectfully submitted,



RUTH MONTALVO

EXHIBIT A



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,425	07/12/2001	Cindy Kohanek	JG-SU-5072	1776

7590 07/03/2002
REED SMITH LLP
Patent, Trademark and Copyright Matters
375 Park Avenue
New York, NY 10152

EXAMINER

BENNETT, GEORGE B

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 07/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKET

DUE

Oct. 3, 2002 Reply Due

Jan. 3, 2003 Reply Deadline

Qf.: MSAD 1001

EXHIBIT B

p37034

15-54-5012

R. Cindy KOHANEK and Gary BABB

IO. 09/904,425 FILED July 12, 2001

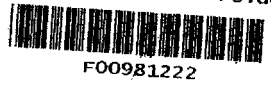
PRIMARY FLAT LINEARITY GAUGE

E Mitsubishi ~~Silicon~~ Materials Silicon Corp.

IENT RECORDED March 11, 2002 REEL 012730 FRAME 0063

OFFICE ACTIONS	AMENDMENTS
P. Reed 8-29-2001	Expected Sep. 18-29-2001 Deadline 2-28-2002
trial 2-13-2002	Attorney 8-13-2002
trial 2-13-2002	
102 RCD	Oct. 3, 2002 Reply / Jan. 3, 2003 Deadline
trial 2-6-2003	
trial 2-6-2003	Continuing Answer to Petition 6-6-2003
informant rec'd 3-26-2003	

Y3079-00047 Folder: 0001



F00981222

Client: SUDA PATENT OFFICE

Matter: LINEARITY MEASURING APPARATUS FOR
WAFER ORIENTATION FLAT, SERIAL NO.
09/904,425 (SU-5072)

Folder: Y3079-00047

Billing: GOLDBERG, JULES

Notice RCVD 12-11-2002
No. 15-2002-0189118-A1
Date: 12-19-2002

hgabde1r

FINAL FEE PAID

IO. DATE

CLIENT OF TITLE
DIVISION OF
CONTINUATION IN PART OF
INVENTOR
CANADIAN
OTHER FOREIGN

JG-SU-5072 Client Ref: M1522705

25

EXHIBIT C

Data...	Doc Name	Number	V...	Doc Categ...	Author	Edit Time
US_AR...	1073242	1,219,268	1	OTHRCORRESPO...	WORDFLOW...	Fri 09/26/2003 4:03 PM
US_AR...	JG-SU-5072 PETITION TO REVIVE	35,150,564	1	OTHRCORRESPO...	JEGOLDBE	Thu 02/06/2003 10:19 AM
US_AR...	JG-SU-5072 LET RE: OFFICE ACTION	35,123,994	1	OTHRCORRESPO...	JEGOLDBE	Fri 09/20/2002 3:57 PM
US_AR...	JG-SU-5072 LET REP OFFICE ACTION	35,116,153	1	OTHRCORRESPO...	JEGOLDBE	Thu 08/01/2002 4:31 PM
US_AR...	JG-SU-5072 LETTER REP. FILING OF MISSING P...	35,100,333	1	OTHRCORRESPO...	JEGOLDBE	Mon 04/22/2002 10:57 AM
US_AR...	JG-SU-5072 REQUEST FOR EXT. OF TIME -MP	35,096,312	1	OTHRCORRESPO...	JEGOLDBE	Wed 02/13/2002 8:37 AM
US_AR...	JG-SU-5072 RESP TO MISSING PARTS	35,096,315	1	OTHRCORRESPO...	JEGOLDBE	Wed 02/13/2002 8:23 AM
US_AR...	JG-SU-5077 MP-LTR	35,091,963	1	OTHRCORRESPO...	RMONTALV	Wed 01/23/2002 7:46 PM
US_AR...	JG-SU-5072 N-LB	35,077,539	1	OTHRCORRESPO...	RMONTALV	Tue 07/24/2001 11:17 AM
US_AR...	JG-SU-5072 NEW	35,077,532	1	OTHRCORRESPO...	RMONTALV	Thu 07/12/2001 12:05 PM
US_AR...	JG-SU-5072 PREL-PRI	35,077,535	1	OTHRCORRESPO...	RMONTALV	Thu 07/12/2001 12:02 PM

EXPRESS MAIL NO. EV 168 022 687 US

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, Washington, D.C. 20231

2009 / Ruth Montalvo

Date: September 16,

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Customer No. 026418
Docket No.: JG-SU-5072/500577.20035
Applicant(s): Cindy KOHANEK, et al.
Serial No.: 09/904,425
For: PRIMARY FLAT LINEARITY GAUGE

Box DAC
Commissioner for Patents
Washington, DC 20231

PETITION TO REVIVE PURSUANT TO 37 CFR 1.137(b)

Sir:

Applicants hereby petition the Commissioner to Revive the above-identified application, which became abandoned for failure to respond to the last office action dated July 3, 2002.

The undersigned hereby states that the Abandonment was unintentional.

Enclosed is a duplicate of this petition, check in the amount of \$ 1,300.00 to cover the fee for the revival and a response to the outstanding Office Action.

The Commissioner is hereby authorized to charge any additional fees which may be required or credit any overpayment to Deposit Account No. 50-1529.

Accordingly, favorable consideration of this Petition is earnestly solicited.

Respectfully submitted,

JEG:dej
February 6, 2003
Tel.(212) 521-5403

Jules E. Goldberg - Reg. No. 24,408
Reed Smith LLP
599 Lexington Avenue
New York, NY 10022

Enclosure(s): Check \$ 1,300.00

Amendment

EXHIBIT 4

YOUR# SU-5072

PRINTED ON: 01/08/2009

COUNTRY	US	UNITED STATES	TITLE		PRIOR	06/18/2001	
NEW/CON	OTH	SERIAL#	09/904,425	LINEARITY MEASURING APPARATUS FOR WAFER ORIENTATION FLAT	MAIL		
RELATED	N/A	PATENT#			FILE	07/12/2001	
TYPE	UTL	STATUS	TRANSFER		PUBL	12/19/2002	
CLIENT	SU	SUDA PAT.OFF. / 500577	1		CREF	ML6227US	
AGENT				AREF		TFD	Y 01/02/2008

ID	O	ACTION	BASE	DUE IN	DUE	EXTNS	FINAL	EXT	RESPONSE	CALL UP	1	2	P
	N	AWAITING MP/OA	07/12/2001	2 M	09/12/2001		09/12/2001	0	09/13/2001	1 M	Y	Y	Y
	N	DECLARATION DUE	08/29/2001	2 M	10/29/2001	4 1	02/28/2002	4	02/13/2002	1 M	Y	Y	Y
	N	FILING RECEIPT	02/13/2002	2 M	04/13/2002		04/13/2002	0	03/26/2002	1 M	Y	Y	Y
	N	3MON DUE DATE	07/03/2002	3 M	10/03/2002	3 1	01/03/2003	3	01/01/1900	1 M	Y	Y	Y
AN	N	AMEND PUBLICATION	12/19/2002	2 M	02/19/2003		02/19/2003	0	11/21/2003	1 M	Y	Y	Y
	N	AB NOTICE/PETITION	03/26/2003	2 M	05/26/2003		05/26/2003	0	01/02/2008	1 M	Y	Y	Y
NOTICE OF ABANDONMENT REC'D DATED 26MARCH2003 BUT THE PTO HAS NOT REC'D THE PETITION FILED 6FEB2003													
SC	N	STATUS CHECK	03/26/2003	6 M	09/26/2003		09/26/2003	0	01/02/2008	1 M	Y	Y	Y
99	N	CASE TRANSFERRED	01/02/2008	0 M	01/02/2008		01/02/2008	0	01/02/2008	0 M	Y	Y	Y
Transferred to J.E. Goldberg @ Duane Morris LLP, 1540 Broadway, New York, NY 10036-4086 JG Direct: 212-692-1025 (firm 212-692-1000 / fax 212-692-1020)													

INVENTORS CINDY KOHANEK GARY BABB	ASSIGNEES MITSUBISHI MAT. SILICON CORP. Mitsubishi Silicon America Corporation	TERMS 500577.20035
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PRIOR APPLICATIONS					
REFERENCE#	CNTRY	SERIAL#	FILED	TITLE / DESCRIPTION	TYPE
	JP	2001-183702	06/18/2001		APPL

USER-DEFINABLE FIELDS STAT Pending PRI# 2001-183702 PBL# US-2002-0189118-A1	PATENT FIELDS SMALL ENTITY No IND CLAIMS TOTAL CLAIMS PUBL # ART UNIT 2859 CONFIRM# 1776 EXAMINER
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P04133US00 ENTERED 01/01/1980 MODIFIED 01/03/2008 2 BY RMT ATTORNEYS JG / N/A / N/A

NOTES
PD Subm w/MP 13FEB02